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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,549	10/27/2005	Graeme Alexander	5253-00002	1418
26753 7590 12/08/2010 ANDRUS, SCEALES, STARKE & SAWALL, LLP 100 EAST WISCONSIN AVENUE, SUITE 1100 MILWAUKEE, WI 53202				
EXAMINER				
GRAY, JILL M				
ART UNIT		PAPER NUMBER		
1798				
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12/08/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/531,549

Applicant(s)

ALEXANDER ET AL.

Examiner

Jill Gray

Art Unit

1798

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-9, 11-31, 33-47 and 49-52 is/are pending in the application.
- 4a) Of the above claim(s) 51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-9, 11-31, 33-47, 49-50, 52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Pursuant to the entry of the amendment of September 22, 2010, the status of the claims is as follows: Claims 1-4, 6-9, 11-31, 33-47, and 49-52 are pending. Claim 51 is withdrawn.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-4, 6-9, 11-31, 33-47, 49-50, and 52 are rejected under under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as being unpatentable over Dickinson, European Patent Application EP 0559382 A1 (Dickinson).

Regarding Independent claims 1 28 and 47

Dickinson discloses a fire resistant composition comprising 10-50% by weight of the total weight of the composition of a polymer base composition, about 5 to 60% by weight of an additive system exclusive of the inorganic oxide constituent, and a first inorganic oxide constituent and a second inorganic oxide constituent which melts at temperatures of less than 1000°C and includes metal oxides, phosphorus oxides and boron oxide, as required by applicants. See entire document, and for example, abstract

and column 5, lines 15-46 and column 8, lines 16-20. The additive system exclusive of the inorganic oxide constituent includes silicate mineral fillers such as mica. See column 6, lines 19-36. Regarding the requirement that after exposure to an elevated temperature the residue remaining is a ceramic in an amount of at least 40% by weight of the total fire resistant composition and wherein the source of fluxing oxide is present in an amount to provide the residue with fluxing oxide in an amount of from 1 to 15% by weight of the residue remaining after exposure to an elevated temperature experienced under fire conditions whereby the fluxing oxide provides binding of the particles of silicate mineral filler to form a coherent ceramic residue at temperatures encountered under fire conditions, Dickinson discloses the same type of composition contemplated by applicants. In particular, Dickinson discloses an organic polymer base, silicate mineral filler, and fluxing oxides, wherein said components are present within the same range as applicants. The same composition necessarily has the same properties. Accordingly, the examiner has reason to believe that the properties of the composition of Dickinson are the same as well, in the absence of factual evidence to the contrary. Moreover, since the prior art teachings set forth a composition whereby the amounts of each component are at least within the minimum required of present claims 1 and 28, and further discloses the formation of a stable char structure, and a rigid foam of ceramic ash (note column 6, line 38), the skilled artisan would reasonably presume that the composition of Dickinson functions in the same manner as applicant's after exposure to elevated temperatures, and has the same or a substantially similar end composition, in the absence of factual evidence to the contrary. "Where the claimed

and prior art products are identical or substantially in structure or composition, or are produced by identical or substantially processes, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *In re Spada*, 911m F.2d 705, 709, 15 USPQ2d 1655, (Fed. Cir. 1990).

Regarding Dependent claims 2-4, 6-9, 11-20, 27-31, 33-45, and 49-50

Regarding claims 2 and 29, Dickinson discloses that the silicate mineral filler is present in an amount of about 5 to 60% by weight. See column 8, lines 16-20.

Regarding claims 3-4, 12-15, 24, 27, 30-31, 35, and 39-41, it is the examiner's position that Dickinson discloses the same type of composition contemplated by applicants. In particular, Dickinson discloses an organic polymer base, silicate mineral filler, and fluxing oxides, wherein said components are present within the same range as applicants. The same composition necessarily has the same properties. Accordingly, the examiner has reason to believe that the properties of the composition of Dickinson are the same as well, in the absence of factual evidence to the contrary.

Regarding claims 6 and 33, as set forth above, Dickinson discloses the formation of a stable char structure, and a rigid foam of ceramic ash (note column 6, line 38).

Regarding claims 7-9, 34, and 37, Dickinson discloses a mixture of inorganic oxides such as glass frits and that other components such as zinc borate can be added.

Also, Dickinson discloses that a commercially available material "CEEPREE" can be used, wherein "CEEPREE" is a mixture of glass frits. See column 5, and column 6.

Regarding claims 9 and 36, Dickinson discloses that the first oxide melts between 350°C to 450°C and that the second inorganic oxide melts at temperatures between about 650°C and 1000°C. See column 5, lines 20-22 and 47-50.

Regarding claims 11 and 38, Dickinson discloses that his composition comprises at least one oxide of an element of the type contemplated by applicants, such as lead or boron.

Regarding claims 16-17 and 42-43, Dickinson discloses an organic base polymer that is of the same type set forth by applicants, such as rubber, polyolefins or vinyl polymers. See column 5, lines 6-15.

Regarding claim 18, Dickinson discloses that the polymer base composition comprises from 10 to 50% by weight of the composition. See column 8, line 17.

Regarding claim 19, Dickinson discloses a silicate mineral filler of the type set forth by applicants. See column 6, line 33.

Regarding claims 20 and 44, Dickinson discloses that his composition includes a first inorganic oxide and a second inorganic oxide, whereby said inorganic oxides can be metal oxides of iron, alkali metals, alkaline earth metals and zinc oxides. See column 5, lines 30-42.

Regarding claims 49-50, Dickinson discloses that his fluxing oxide comprises fluxing components that are of oxides of the type set forth by applicants. As to the language of "consisting essentially of", the transitional phrase "consisting essentially of"

limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. For the purpose of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." In an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. See MPEP 2111.03.

Regarding claim 45, Dickinson discloses a fire resistant cable of the type set forth by applicants. See Figure 1.

Therefore, the teachings of Dickinson anticipate or in the alternative, render obvious the invention as claimed in present claims 1-4, 6-9, 11-20, 27-31, 33-45, 47, and 49-50.

5. Claims 21-23, 25-26, 46 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickinson, European Patent Application EP 0559382 A1 (Dickinson) in view of Romenesko et al., 6,433,049 B1 (Romenesko), for reasons of record. Dickinson is as set forth above, but does not teach the inclusion of a silicone polymer.

Romenesko is as set forth in the previous Office Action and teaches a fire resistant composition that can be used as cable and wire insulation, said composition comprising a polyolefin, a silicone polymer, and particulate silicate mineral filler, wherein

each component is present in amounts within the present claimed ranges. See entire document, and for example, abstract and column 4, lines 10-20.

It would have been obvious to one having ordinary skill in the art to modify the composition of Dickinson by adding a silicone polymer, as taught by Romenesko with the reasonable expectation of the silicon polymeric material in the composition of Dickinson as modified by Romenesko becoming ceramified upon exposure to high temperature, and yielding a dense ceramic with excellent dimensional stability, strength and electrical insulating properties.

Therefore, the combined teachings of Dickinson and Romenesko would have rendered obvious the invention as claimed in present claims 21-23, 25-26, 46, and 52.

Response to Arguments

6. Applicant's arguments filed September 22, 2010 have been fully considered but they are not persuasive.

Applicants argue that Dickinson does not disclose that the fluxing oxide is present in an amount from 1 to 15% by weight of the residue after exposure to an elevated temperature experienced under fire conditions.

In this regard, the fact that Dickinson is silent as to this property does not provide evidence to its absence. Dickinson teaches the same components as applicants that are included in the composition within the ranges claimed by applicants. In particular, present claim 1 requires "at least 15% by weight of a polymer base composition, at least 15% by weight of particulate silicate mineral filler and at least one source of fluxing oxide, but no specific amount. Dickinson discloses a composition containing the same

components that are present in amounts that within applicants' claimed range.

Furthermore, applicants have provided no evidence that the amount of fluxing oxide disclosed by Dickinson does not result in a residue in an amount of from 1 to 15% by weight.

Applicants argue that Dickinson does not disclose that the fire retardant material comprises a specific amount of the silicate mineral filler, in particular, at least 15% by weight of the silicate mineral filler based on the total weight of the composition.

The examiner disagrees. In particular, Dickinson discloses that the silicate mineral filler is present in an amount of about 5 to 60% by weight. See column 8, lines 16-20. Clearly this teaching renders obvious the present claimed "at least 15% by weight."

Applicants argue that the specification Examples discloses the importance of the silicate mineral filler and the fluxing oxide and demonstrates the criticality of the proportions of these components for minimizing shrinkage and maximizing flexural strength, further arguing that the declaration of Don Rodrigo clearly shows the critical nature of the fluxing oxide and its proportion by weight of non-combustible material for minimizing shrinkage and maximizing flexural strength and that Dickinson includes no Examples or disclosure that suggests the importance of silicate mineral filler and fluxing oxide and the criticality of the proportions of these components for minimizing shrinkage and maximizing flexural strength.

In this regard, it is the examiner's position that the Examples in the specification are not commensurate in scope with the present claims. The present claims do not

contain a specific amount of fluxing oxide, and the language of "at least 15% by weight" encompasses all amounts from 15% by weight to 85% by weight. Also, the Don Rodrigo declaration has been previously addressed.

Applicants argue that claims 21-23, 25, 26, 46, and 52 are patentable over Dickinson in view of Romenesko for the reasons stated above.

In this regard, the examiner disagrees for the reasons stated above and incorporated herein.

No claims are allowed.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-Th and alternate Fridays 10:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jill Gray/
Primary Examiner
Art Unit 1798

jmg